UNITED STATES PATENT AND TRADEMARK OFFICE

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09/309,831	05/11/1999	THOMAS C. MIELENHAUSEN	33197.8	8013

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EXAMINER
HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *08 November 2007*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-22* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: amendment filed 11/8/07 to the

application filed on 5/11/99.

2.   Claims 1-22 are pending in the case. Claims 1, 15, 17 are independent claims.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claim 13 remains rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Regarding claim 13, as stated in the previous action, the insertion of abbreviation can

be carried out *only at the position of a word having a corresponding abbreviation, not at*

any other positions of other words in the text that do not have corresponding

abbreviation. Therefore, claiming that inserting is carried out "at <u>any position</u> in the

existing text" includes inserting at the positions of the words *that do not have*

corresponding abbreviations also. This is opposite to the disclosure of the application

where the insertion occurs only at specific positions – the positions of the words having

corresponding abbreviation. So, to be clear, the limitation should be "at any position in

the existing text having a corresponding abbreviation."

5.   Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Regarding claim 14, it is confusing to select an abbreviation <u>from the second data</u>

<u>structure</u> and inserting the abbreviation into the pre-existing text *since the second data*

structure includes a plurality of abbreviations and corresponding words, and since

<u>selecting an abbreviation is appropriately performed from the first data structure in claim</u>

<u>13.</u>

Actually, a word should be <u>selected from the second data structure</u> and the selected

word is inserted in a position of an abbreviation in a pre-existing text to replace the

abbreviation.

If it is believed that selecting an abbreviation can be performed from both the first data

structure or the second data structure, then it's better to define and <u>use only one data</u>

<u>structure</u> since they both include words and corresponding abbreviations and vice

versa.   There is no need to differentiate the two data structures as claimed.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ichbiah (US Pat No. 5,623,406, 4/22/97, filed 3/6/95) in view of Goldwasser (US Pat No.

5,096,423, 3/17/92, filed 12/29/87) and Shaw et al., Microsoft Office 6-in-1, Que

Corporation 1994, pages 171-172, 212-213.

Regarding independent claim 1 and its dependent 9-10, Ichbiah discloses:

-   storing in the memory a second data structure encoding a plurality of

    abbreviations and corresponding words (col 4, lines 53-67: a glossary of

    abbreviations and the corresponding words and phrases is stored in the system;

    col 5, line 25 to col 6, line 18; abstract: "retrieving words and phrases from

    abbreviations" inherently shows there is a list of abbreviations and corresponding

    words and phrases for retrieving)

-   displaying a list of suggested words and phrase corresponding to the selected

    abbreviation, and receiving input from the user to choose the desired word and

    phrase for the abbreviation (col 4, lines 53-67: the fact that multiple matching

    words and phrases for a proposed abbreviation are displayed by the system in

    the form of option in advisory table upon the entry of characters into the system

    shows displaying a list of suggested words and phrases for an abbreviation for

    selecting; col 12, lines 42-67: more than one choice of matching words are

    displayed to users for selecting)

Ichbiah does not explicitly disclose:

-   storing in the memory a first data structure encoding a plurality of words and

corresponding abbreviations

- actively selecting an abbreviation in the pre-existing text to be converted to a

   word, converting the selected abbreviation to a corresponding word using the

   second data structure, and replacing the abbreviation with the corresponding

   word

- actively selecting a word in the pre-existing text to be converted to an

   abbreviation, converting the selected word to a corresponding abbreviation using

   the first data structure, and replacing the word with the corresponding

   abbreviation

Goldwasser discloses:

- storing in the memory a first data structure encoding a plurality of words and

   corresponding abbreviations (col 5, lines 27-33: storing the sequences of

   keypresses, which are long sequences of characters of words, and the

   correspondent abbreviations, both are formed a first data structure as claimed)

Shaw discloses the Find and Replace feature for selecting a word in a pre-existing text,

converting a word to a desired word and replace the word with the desired word (pages

171-172). Shaw also discloses the AutoText feature for automatically replacing a word

with a word in a collection of commonly used words defined by a user (pages 212-213).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Shaw into Ichbiah and Goldwasser for the following

reason. The replacing feature in Shaw using a collection of defined words, which is a

list of defined words, suggests that when applying Find and Replace, a defined list of

corresponding words can be used by a user. By analogy, the Find and Replace can be applied on a pre-existing text using the provided first data structure and the provided second data structure as in Ichbiah and Goldwasser for replacing a selected word in a pre-existing text to a corresponding abbreviation and vice versa.

Regarding claims 2 and 16, Ichbiah discloses editing, updating and customizing the data structures, which are words and corresponding abbreviations (col 7, line 55 to col 8, line 47; col 14, lines 3-27; col 11, line 35 to col 12, line 40). Lu also discloses these features (col 3, lines 17-36; col 5, lines 20-68).

Regarding claims 3-6, Ichbiah discloses that the word or an abbreviation is selected by a user using a keyboard command or using a mouse (col 3, lines 63-65; col 6, line 53 to col 7, line 3; col 12, line 60 to col 13, line 5; col 14, lines 29-58).

Regarding claims 7-8, 11-12, Ichbiah discloses:
- displaying a list of suggested abbreviations corresponding to the selected word and receiving input from the user to choose the desired abbreviation (col 5, lines 15-60)
- scanning the text for abbreviations to be converted to words or phrases and converting the abbreviation selected by the data processing to corresponding word (col 5, lines 16-24; col 6, line 33 to col 7, line 3; col 14, line 29 to col 15, line 55: recognizing an entry of abbreviation for a corresponding word or phrase

based on the glossary of words and abbreviations implies scanning the entered

text for a corresponding word or phrase; col 12, line 42 to col 13, line 20:

converting the abbreviations to corresponding words or phrases by input

command from a user)

- receiving input from the user to choose the desired abbreviation corresponding to

the phrase or to choose the desired phrase corresponding to the abbreviation

(col 12, line 42 to col 13, line 20)

Ichbiah does not explicitly disclose:

- displaying a list of suggested words and phrases corresponding to an

abbreviation

- scanning the text for words to be converted to abbreviations and converting

words selected by the data processing to corresponding abbreviation

- replacing the words in the pre-existing text with the corresponding abbreviations

Goldwasser discloses:

- a list of suggested words and phrases corresponding to an abbreviation (col 3,

lines 8-37: providing a menu of linguistic expressions of words and phrases

having corresponding abbreviation for users to select one)

- scanning the text for words to be converted to abbreviations and converting

words selected by the data processing to corresponding abbreviation (col 2, line

50 to col 3, line 55: recognizing the entry data of a word for a corresponding

abbreviation implies that the text is scanned for a word to be converted to an

abbreviation)

Goldwasser do not disclose:

- replacing the words in the pre-existing text with the corresponding abbreviations

Shaw discloses the Find and Replace feature for selecting a word in a pre-existing text, converting a word to a desired word and replace the word with the desired word (pages 171-172). Shaw also discloses the AutoText feature for automatically replacing a word with a word in a collection of commonly used words defined by a user (pages 212-213). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Shaw into Ichbiah and Goldwasser for the following reason. The replacing feature in Shaw using a collection of defined words, which is a list of defined words, suggests that when applying Find and Replace, a defined list of desired words can be used by a user. By analogy, the Find and Replace can be applied on a pre-existing text using the provided first data structure and the provided second data structure as in Ichbiah and Goldwasser for replacing a selected word in a pre-existing text to a corresponding abbreviation and vice versa.

Regarding claims 13-14, Ichbiah does not disclose selecting an abbreviation from the first data structure and from the second data structure and inserting the abbreviation into the pre-existing text.

Shaw discloses the Find and Replace feature for selecting a word in a pre-existing text and replace the word with the desired word (pages 171-172). Shaw also discloses the AutoText feature for automatically replacing a word with a word in a collection of commonly used words defined by a user (pages 212-213).

Response to Arguments

8.   Applicant's arguments with respect to claims 1-22 have been considered but are

moot in view of the new ground(s) of rejection.

Applicants argue that the text in Ichbiah and Goldwasser is not a pre-existing text, and

so replacing a selected abbreviation with a corresponding word and replacing a

selected word with a corresponding abbreviation are not performed in a pre-existing

text.

Examiner agrees.   Shaw discloses the argued feature.

Applicants also argue that the indefinite article "a" is construed to mean "one or more",

and therefore the language "at a position" should be interpreted as "at one or more

positions" (Remarks, page 13).

Examiner sees nowhere in the specification of the instant application such specific

definition for the article "a." Therefore, "at a position" is interpreted with a plain meaning

"at one position."

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Batchelder et al. (US 5,691,708).

Kudrolli et al. (US 6,279,018).

Beutnagel et al. (US 2003/0115049).

Matsumoto et al. (US 2004/0249819).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Shaw into Ichbiah and Goldwasser for the following reason. The replacing feature in Shaw using a collection of defined words, which is a list of defined words, suggests that when applying Find and Replace, a defined list of desired words can be used by a user. By analogy, the Find and Replace can be applied on a pre-existing text using the provided first data structure and the provided second data structure as in Ichbiah and Goldwasser for selecting an abbreviation from the first data structure and the second data structure, and inserting the selected abbreviation in a pre-existing text at a position of a corresponding word .

Independent claim 15 includes the same limitations as in claims 1, 9-10, and 13-14, and is rejected under the same rationale.

Independent claim 17 and its dependent claim 22 are for a data processing apparatus for performing the method claims 1, 9-10, and 13, and are rejected under the same rationale.

Claims 18-22 are for a data processing apparatus of method claims 7-8, 11-12, and are rejected under the same rationale.

Conkie (US 2007/0282608).

Land et al. (US 2007/0288558).

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-

4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cong-Lac Huynh/
Cong-Lac Huynh
Primary Examiner
Art Unit 2178
1/15/08